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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,631	07/28/2003	Fred Monroe	03-748	4899

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MBHB/TRADING TECHNOLOGIES
300 SOUTH WACKER DRIVE
SUITE 3200
CHICAGO, IL . 60606

EXAMINER

AKINTOLA, OLABODE

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/628,631		MONROE ET AL.	
	Examiner		Art Unit	
	Olabode Akintola		3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 12-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-11 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/13/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's communication filed on March 9, 2006. Claims 1-22 pending in the application are subjection to restriction/election as discussed below. After a phone call on June 1, 2006, a provisional election was made by Mr. Mark Triplett (Attorney for the Applicants) to prosecute claims 1-11 and 22. Accordingly claims 12-21 are withdrawn from consideration as being directed to non-elected invention. Applicant is respectfully requested to cancel the withdrawn non-elected claims 12-21 of invention II in response to this office action. Claims 1-11 and 22 have been examined. The restriction/election and rejections are stated below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- Invention I: Claims 1-11 and 22 are drawn to a method and system for sending and order on behalf of a trader from a first electronic market to a second electronic market.
- Invention II: Claims 12-21 are drawn to system for managing an order at a first electronic market on behalf of a trader.
3. The inventions I and II are distinct, each from the other because of the following reasons:
- Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable.

In the instant case, invention I relates to a method and system for sending and order on behalf of a trader from a first electronic market to a second electronic market, whereas invention II relates to a method and system for managing an order at a first electronic market on behalf of a trader. The system of invention I can be performed by a system configuration different from what is claimed in invention II. Hence invention I has a different utility and scope than invention II. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

After a phone call on June 1, 2006, a provisional election was made by Mr. Mark Triplett (Attorney for the Applicants) to prosecute claims 1-11 and 22.

Accordingly claims 12-21 are withdrawn from consideration as being directed to non-elected invention. Applicant is respectfully requested to cancel the withdrawn non-elected claims 12-21 of invention II in response to this office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 22 are not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble the claim refers to a method, but the body of the claim discusses the specifics of the system (“ wherein the electronic market comprises..”) and subsequently the claim then deals with the specifics of a method step (“the order being sent..”).

A claim is considered indefinite if it does not apprise those skilled in the art of its scope. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F. 2d 1200, 1217 (Fed. Cir. 1991).

Claims 2-11 are rejected as being dependent on claim 1 as discussed above.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 and 22 are rejected under 35 U.S.C. §101 because the claimed invention is directed to a non statutory subject matter.

35 U.S.C. §101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture or composition of matter or new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101. The claim begins by discussing a method (ex. Preamble of claims 1 and 22), the body of the claim discusses the specifics of the system (“wherein the electronic market comprises...”) and method (“the order being sent...”) (see rejection of claims under 35 U.S.C. §112, second paragraph, for

specific details regarding this issue). "A claim of this type is precluded by express language of 35 U.S.C. §101 which is drafted so as to set forth statutory the statutory classes of invention in the alternative only", Ex parte Lyell (17USPQ2d 1548).

For examination purpose, the examiner will give these claims their broadest interpretation and treat them as process claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10, 11 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Garber (U.S. Patent No. 5963923).

Re claims 1 and 22: Garber teaches a method for sending an order to an electronic market, comprising: sending an order on behalf of a trader from a first electronic market to a second electronic market (col. 4, lines 5-8), wherein the first electronic market comprises a first computerized matching process that is configured to automatically match bids and offers received from remote client devices to trade a first tradable object and the second electronic market comprises a second computerized matching process that is configured to automatically match bids and offers received from remote client devices to trade a second tradable object and wherein the second tradable object is different from the first tradable objects (col. 4, lines 38-42), the order being sent using a microprocessor executing one or more instructions (col. 4, lines 5-8 & lines 32-44).

Re claim 2: Garber teaches the step of sending is performed when a condition is satisfied (col. 6, lines 45-55)

Re claim 3: Garber teaches the step of receiving a first order at the first electronic market (col. 4, lines 32-36).

Re claim 4: Garber teaches the step wherein the condition comprises at least a portion of the first order being filled (col. 6, lines 45-55).

Re claim 5: Garber teaches the step of receiving a market event request message at the first electronic market that establishes a condition (col. 8, lines 14-27).

Re claim 6: Garber teaches the step wherein the condition is in the form of a lookup table (col. 8, lines 20-22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garber (U.S. Patent No. 5963923) in view of Bykowsky et al. (U.S. Patent Application No. 20020013757) (hereinafter referred to as Bykowsky).

Re claim 7 and 8: Garber is as discussed above. Garber does not explicitly teach the step of sending a message from the first electronic market to the second electronic market instructing the second electronic market to modify the order sent on behalf of the trader. Bykowsky teaches the step of sending a message from the first electronic market to the second electronic market instructing the second electronic market to modify the order sent on behalf of the trader (section [0055]: *buyers and sellers have one or more opportunities to modify a previously submitted buy or sell order*). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Garber to include the step of sending a message from the first electronic market to the second electronic market instructing the second electronic market to modify the order sent on behalf of the trader as taught by Bykowsky. One would have been motivated to do this in order to provide an opportunity to adjust a previously submitted order.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garber (U.S. Patent No. 5963923) in view of Hauk et al. (U.S. Patent Application No. 20030126068) (hereinafter referred to as Hauk).

Re claim 9: Garber is as discussed above. Garber does not explicitly teach the step wherein the electronic market comprises a matching engine that matches bids and offers for a given market according to a first-in-first-out (FIFO) matching algorithm. Hauk teaches the step wherein the electronic market comprises a matching engine that matches bids and offers for a given market according to a first-in-first-out (FIFO) matching algorithm (section [0066]: *An algorithm for trade matching, based on prorated or FIFO trading match scheme could be incorporated*). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Garber to include the step wherein the electronic market comprises a matching engine that matches bids and offers for a given market according to a first-in-first-out (FIFO) matching algorithm as taught by Hauk. One would have been motivated to do this because FIFO matching scheme is old and well known in the art.

Response to Arguments

Applicant's arguments with respect to claims 1-11 and 22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



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PRIMARY EXAMINER